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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/471,523 12/23/99 VAN BREEMEN

R 21726/90386

HM12/1103

BARNES & THORNBURG  
2600 CHASE PLAZA  
10 SOUTH LASALLE STREET  
CHICAGO IL 60603

EXAMINER

GARCIA, M

ART UNIT PAPER NUMBER

1627

DATE MAILED:

11/03/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

## Office Action Summary

Application No.

09/471,523

Applicant(s)

Van Breemen et al

Examiner

Maurie E. Garcia, Ph. D.

Group Art Unit

1627



Responsive to communication(s) filed on \_\_\_\_\_

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle 1035 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire ONE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

### Disposition of Claim

Claim(s) 1-11 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) \_\_\_\_\_ is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims 1-11 are subject to restriction or election requirement.

### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

## **DETAILED ACTION**

**Note:** In an effort to enhance communication with our customers and reduce processing time, Group 1627 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-308-4315. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Jyothsna Venkat, Supervisory Patent Examiner, at (703) 308-2439. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

### ***Election/Restriction***

1. This application contains claims directed to the following patentably distinct species of the claimed invention:
2. Election from the following species is required. Note: applicant must elect **one** species from **each** of the groups (Groups 1-3) below.

#### **Group 1: Species of biological material**

A. Protein	B. Peptide
C. Oligonucleotide	D. Oligosaccharide
E. Microsome	F. Cell
G. Tissue	H. Enzyme
I. Receptor	J. DNA
K. RNA	

The species are distinct, each from the other, because their structures and modes of action are different. Specifically, they would differ in their interaction with the compound of interest. Moreover, each of the above species can be separately classified. Therefore, the species have different issues regarding patentability and represent patentably distinct subject matter.

Group 2: Species of compound

- A. Natural product
- B. Combinatorial library
- C. Drug
- D. Drug mixture
- E. Xenobiotic compound
- F. Mixture of xenobiotic compounds
- G. Endogenous compound
- H. Mixture of endogenous compounds

The species are distinct, each from the other, because their structures and modes of action are different. Specifically, they would differ in their interaction with biological material. Moreover, each of the above species can be separately classified. Therefore, the species have different issues regarding patentability and represent patentably distinct subject matter.

Group 3: Species of predetermined characteristics

- A. Functioning as a substrate for an enzyme
- B. Showing desirable rates of enzymatic catalysis
- C. Showing desirable rates of cell permeability or transport
- D. Showing enzymatic activation to reactive or toxic metabolites

The species are distinct, each from the other, because their modes of action are different. They would also necessitate different compounds and biological materials since each of the characteristics differ in the measured effect. Moreover, each of the above species can be separately classified. Therefore, the species have different issues regarding patentability and represent patentably distinct subject matter.

3. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.
4. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.
5. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).
6. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

7. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maurie E. Garcia, Ph.D. whose telephone number is (703) 308-0065. The examiner can normally be reached on Monday-Thursday from 9:30 to 7:00 and alternate Fridays.

9. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jyothsna Venkat, can be reached on (703) 308-2439. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

  
DR. JYOTHSNA VENKAT PH.D  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600

Maurie E. Garcia, Ph.D.  
October 20, 2000